Amendment dated 07/14/05   Application No. 09/945,469
Response to Office Action dated 03/24/05

REMARKS

Claims 1-44 are pending. Claims 1-44 stand rejected.

While the Office Action Summary indicates that the action is final, the detailed action does not discuss the finality. Pursuant to the telephonic discussion on May 25, 2005, the Examiner confirmed that the Office Action is non-final in the Interview Summary.

The Applicants thank the Examiner for the telephonic interview on July 5, 2005 to discuss proposed amendments to the claims.

Claims Rejections – 35 U.S.C. §112

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Regarding claim 1, the Applicants are amending the claim to be directed to "A computer-readable medium having computer-executable components." The amendment is supported by the specification as originally filed, e.g., Figure 1 and paragraph 35. The instructions are positively claimed in claim 1 as steps that are performed by computer-executable instructions of a computer-readable medium.

Similarly, the Applicants are amending independent claims 2, 13, and 17 to be directed to "A computer-readable medium having computer-executable instructions." The claimed instructions should be given patentable weight for at least the above reasons. Claims 3-12, 14-16, and 18-20 ultimately depend from claims 2, 13, and 17. Thus, the Applicants are requesting reconsideration of claims 1-20.

Claims Rejections – 35 U.S.C. §101

Claims 21-35 and 42-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Office Action alleges that the claimed invention is not within the technological arts.

-15-

The Applicants have amended independent claims 21, 23, 24, 30, and 35 to clar fy that all the steps are performed on the claimed computer system and that the invention is within the technological arts. The Office Action alleges that (Page 6.):

> the claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed without the use of technoloy. The method steps of "sending by a first computer to a second computer an inqu iry to an intermediate entity ..." may be understood as merely sending a ile containing information regarding said inquiry without altering said informat on (file), which would constitute trivial use of technology. However, the claimed invention must utilize technology in a non-trivial matter (*Ex parte Bowman, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)*). Although Bowman is not precedential, it has been cited for analysis.

The Applicants respectfully disagree with the above allegation. The degree of technological complexity is not relevant to the rejections of claims 21-35 and 42-43 under 35 U.S.C. § 101. In accordance with MPEP 2106 (IV)(B)(2)(b), claims 21-35 and 42-43 are limited to a practical application within the technological arts. For example, regarding claim 21, the claim is directed to "A method, in a computer system, of establishing a new business relationship with a sought entity over a network" and to include the features of "sending, **by a first computer t**) **a second computer**, an inquiry to an intermediate entity to determine if the intermediate en ity has an existing relationship with the sought entity;" and "receiving, **by the first computer**, a response from the intermediate entity indicating an existing relationship between the sought en ity and the intermediate entity". (Emphasis added.) Claim 21 is clearly claimed to a practical application within the technological arts. The Office Action further alleges that (Page 6. Emphasis added.):

> As to technological arts recited in the **preamble**, mere recitation in the prearible (i.e., intended or field of use) [of] a network system, or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract dea unless there is a positive recitation in the claim as a whole to breathe life and meaning into the **preamble**.

While claim 21 recites an intended use in a technological field, the elements o' the claim includes technological features that limit the claimed invention to a practical application within the technological arts. For example, claim 21 includes the features of "sending, **by a first computer to a second computer**, an inquiry to an intermediate entity to deter nine if the intermediate entity has an existing relationship with the sought entity" and "receiving, **by the**

-16-

first computer, a response from the intermediate entity indicating an existing relationship between the sought entity and the intermediate entity." (Emphasis added.)

Similarly, independent claims 23, 24, 30, and 35 include the features that limit the claimed invention to a practical application within the technological arts. For example, claim 23 includes the features "querying, **by a first computer to a second computer,** at least one trusted company to determine the existence of a relationship between the at least one trusted company and the unknown company" and "receiving, **by the first computer,** a confirmation of a relationship between the at least one trusted company, the confirmation being indicative of a trust level of the unknown company by one of the at least one trusted company and a corresponding at least one valuation criterion, the trust level of the unknown company being dependent on the corresponding at least one valuation criterion." (Emphasis added.) Also, claim 24 includes the features of "receiving, **by an associated computer,** at a second entity a contact identifying a first entity" and "querying, **another computer by the associated computer,** if the first entity is not a trusted entity and if a proxy parameter is indicative that trusted entities are permitted to forward requests to other trusted parties, the trusted entities and specifying a predetermined degree of separation." (Emphasis added.) Claim 30 includes the features of "receiving, **by an associated computer,** at a second entity a contact identifying a first entity" and "querying, **another computer by the associated computer,** if the first entity is not a trusted entity and if a proxy parameter is indicative that trusted entities are permitted to forward requests to other trusted parties, by the second entity at least a third entity of the trusted entities associated with the second entity, and specifying a predetermined degree of separation." (Emphasis added.) Also, claim 35 includes the feature of "contacting, **between a first computer and a second computer,** a first company by a second company regarding a potential relationship." (Emphasis added.) Moreover, claims 22, 25-29, 31-34, and 42-43 ultimately depend from claim 21, 24, 30 and contain statutory subject matter for at least the above reasons. The Applicants request reconsideration of claims 21-35 and 42-42.

Regarding depend claims 25-29, 31-34, and 42-43, the Office Action further alleges that (Page 7):

> As to "wherein" clause, it merely states the intended use of the invention, or the result of the limitations in the claim, and adds nothing to the patentability of the claim.

The Applicants respectfully disagree. The "wherein" clauses in claims 25-29, 31-34, and 42-43 recite additional features and are not merely directed to the intended use of the inven ion or the result of the limitations of the claims. However, the Applicants are amending claims 25-29, 31-34, and 42-43 to clarify the additional features previously contained in the "wherein" c auses.

Claims Rejections – 35 U.S.C. §102

Claims 1-20, 23, and 44 are rejected under 35 U.S.C. 102(e) as being anti ipated by US 202/0128939 (Tarrant).

As previously discussed, the steps, as claimed in independent claims 1, 2, 13, 7, 23, and 44, should be given patentable weight. Regarding claim 1, The Office Action allege: that Page 7.):

> Information as to content of the instructions, including: receiving an inqu ry; receiving a response; indicating availability of establishing new relationsl ip; indicating a trust level about the sought entity by the intermediate entity; md determining whether information can be shared, is given no patentable wei ght.

As previously discussed, the components, as claimed in claim 1, should be given patentable weight because the components are positively claimed with a computer-readable med um having computer-executable components. The Office Action further alleges that (Page 8 Emphasis added.):

> Claims Directed to an Apparatus must be distinguished from the prior art in te ms of **structure rather than function**, In re *Danly* 263 F. 2d 844, 847, 120 US PQ 582, 531 (CCPA 1959)".

In *In re Danly*, the press structure of disputed claims 1 and 2 was not distinguishe l from any other tie rod in the prior art because "an alternating current may be passed through any tie rod which is insulated from the press frame". (120 USPQ 532.) Claim 1 is claimed in la iguage that describes a computer-readable medium rather than function. At least the claimed feal ures of "an inquiry receiving component for receiving an inquiry from the seeking entity", 'a response receiving component for receiving a response indicating an existing relationship t etween the sought entity and an intermediate entity", "a confirming component for confirming, t ised on the response, that the new relationship may be established, the response being indicativ : of a trust level of the sought entity by the intermediate entity regarding the existing relationsl ip", and "a verification component for determining whether information can be shared betweei entities in accordance with rights management" are not found in Tarrant, and the Office Acti n does not

-18-

even allege that they are found in Tarrant. Because all the features are not taught in Tarrant, the Applicants request reconsideration of claim 1.

> Regarding claim 2, the Office Action alleges that (Page 8.):

> Information as to content of the database and instructions, including: characteristics of entities; a level of trust being gauged by the at least one characteristic; and a parameter relative to an exchange between two entities is given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of **structure rather than function,** *In re Danly* 263 F. 2d 844, 847, 120 USPQ 582, 531 (CCPA 1959)".

Claim 2 is similarly claimed in language that describes a computer-readable medium rather than function. At least the claimed features of "generating at least one entity trust list containing at least one characteristic of at least two of the entities, a level of trust being gauged by the at least one characteristic" and "generating at least one transactional trust list containing a. least one parameter relative to an exchange between at least two of the entities through at least one degree of separation between the entities, the at least one parameter comprising a proxy parameter, the proxy parameter being indicative of an action that a trusted party can perform on behalf of a trusting party" are not found in Tarrant, and the Office Action does not even allege that they are found in Tarrant. Because all features are **not** taught in Tarrant, the Applicants request reconsideration of claim 2.

> Regarding independent claim 13, the Office Action alleges that (Page 9.):

> Information as to content of the database and instructions, including characteristics of entities; a level of trust being gauged by the at least one characteristic; and a parameter relative to an exchange between two entities; a parameter being indicative of an action that a trusted party can perform; a capability domain for each of the at least two entities, is non-functional language and given no functional [patentable] weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*".

Claim 13 is also similarly claimed in language that describes a computer-readable medium rather than function. At least the claimed features of "generating an entity trust list containing at least one characteristic of at least two of the entities, a level of trust being gauged by the at least one characteristic" and "generating a transactional trust list containing at least one parameter relative to an exchange between at least two of the entities through at least one degree of separation between the entities, the at least one parameter comprising a proxy parameter, the proxy

-19-

parameter being indicative of an action that a trusted party can perform on behalf ol a trusting party" and "generating a capability domain and activity trust level data base for eac ι of the at least two entities, the data base having a plurality of levels of trust and a plurality of e ιtity roles, the capability domain and activity trust data base comprising a plurality of entries, ;ach entry being indexed by an entity role and a level of trust, each said entry being indicative of a corresponding business process" are not found in Tarrant, and the Office Action doe; not even allege that they are found in Tarrant. Because all features are **not** taught in T urrant, the Applicants request reconsideration of claim 13.

> Regarding claim 17, the Office Action alleges that (Page 12.):
>
> Information as to content of the database and instructions, including a capabi ity for each of the at least two entities; a plurality of levels of trust and a pluralit; of entity roles, is given no patentable weight. Claims Directed to an Apparatus n ust be distinguished from the prior art in terms of structure rather than function. *I, re Danly*".

Claim 17 is claimed in language that describes a computer-readable medium. At least the claimed feature of "configuring a capability domain and activity trust level data base for each of the at least two entities, the database having a plurality of levels of trust and a plurali :y of entity roles" is not found in Tarrant, and the Office Action does not even allege tha: it s found in Tarrant. Because all features are not taught in Tarrant, the Applicants request recons deration of claim 17.

> Regarding claim 44, the Office Action alleges that (Page 14.):
>
> Information as to specific content of said databases, and said information a; to storing a trust level for each directly interconnected entity and at least one corresponding valuation criterion for determining the trust level is giver no patentable weight. Claims Directed to an Apparatus must be distinguished f om the prior art in terms of structure rather than function. *In re Danly*".

Claim 44 is claimed in language that describes a computer-readable medium rather th an function and is distinguished from prior art in terms of structure and is distinguished from prior art in terms of structure. At least the claimed feature of "creating a trust component that s ores a trust level for each directly interconnected entity and at least one corresponding valuation riterion for determining the trust level and that obtains an associated trust level of a sought entit) through an interconnected intermediate entity if the sought entity is not directly interconne ;ted to the selected entity" is not found in Tarrant, and the Office Action does not even alle ;e that it is

-20-

found in Tarrant. Because all features are not taught in Tarrant, the Applicarts request reconsideration of claim 44.

Regarding claim 23, the Office Action alleges that Tarrant teaches "Said method, comprising: sending an inquiry to an intermediate entity; receiving a response from the intermediate entity; establishing a new business relationship with the sought entity based on the response, the response being indicative or [of] a sought entity and of a corresponding valuation criterion (trustworthiness) [0018]; [0021]". However, Tarrant does not teach the feature of "receiving a confirmation of a relationship between the at least one trusted company, the confirmation being indicative of a trust level of the unknown company by one of the at least one trusted company and **a corresponding at least one valuation criterion, the trust level of the unknown company being dependent on the corresponding at least one valuation criterion.**" (Emphasis added.) Tarrant does disclose (Paragraph 0018. Emphasis added.):

> (d) in response to the request from the second user, transmitting the data from the relational database to a second user computer, wherein, absent a request from the second user for data from a specific source or **level of trustworthiness,** the data transmitted comprise data from users of the highest level of trustworthiness available. In particular embodiments, data received from the first user comprise alternative investment data; sources of the highest level of trustworthiness comprise investment managers, fund administrators, or fund sponsors; sources of at least one level of trustworthiness comprise investors, and the investor level is subdivided into two or more sublevels that are determined at least partly by reliability of previously submitted information; sources of at least one level of trustworthiness comprise investors, and the investor level is subdivided into two or more sublevels, and an investor's sublevel is determined at least partly by amount of demand for the investor's information by other investors; and alternative investment data from the first user comprise fund data.

Tarrant merely teaches about a trust level and not about a trust level **and** a corresponding valuation criterion, from which the trust level is dependent.

Claims 3-12, 14-20, and 40-41 ultimately depend from claims 1, 2, 13, and 17. The Applicants request reconsideration of claims 1-20, 23, and 44.

Claims Rejections – 35 U.S.C. §103

Claims 21-22, 24, 30, 35-36, and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0128939 (Tarrant) in view of US 2002/0078003 (Krysiak).

Regarding claim 21, the Office Action admits that "Tarrant does not expli :itly teach establishing a business relationship with the sought entity based on the response." Ho wever, the Office Action alleges that "Krysiak et al. teach [teaches] a method and system for dentifying information sources based on one or more trust networks associated with one or more :nowledge domains, wherein a business relationship is established based upon an evaluation of t ustworthy [trustworthiness] of a sought party [0014]." However, Krysiak does not teach or ev :n suggest the feature of "establishing the new business relationship with the sought entity ba ;ed on the response, the response being indicative of a trust level of the sought entity by the ir termediate entity and of a **corresponding valuation criterion, the trust level being depend·nt on the corresponding valuation criterion.**" (Emphasis added.) Krysiak does teach [0014]:

> The present invention eliminates the user's need to wade through numerous e-r ail responses in conjunction with a widely-disseminated request for an informa ion source. It also eliminates a user's reliance on Newsgroups to located des red information. It efficiently and explicitly addresses the problem of expei :ise location within an organization. It allows a database to learn from the type: of information sources that users search for. It recognizes that the true value of n ost corporate information is the way in which it connects people to people, allov ing them to share their expertise at the moment of inquiry, thus realizing ind appreciating that cutting-edge thinking is always changing in a way tht t a traditional, static, and centrally-maintained knowledge database cannot captur :. It accepts search requests for an information source and provides a path connec ion to the information source based on a computed trust probability that the information source will be deemed reliable. The computed probability reflect ; an individual's self-evaluation and various peer-evaluations in a given knowle dge domain. The present invention thus facilitates the selection of an expert withi ι an organization by identifying various knowledge domains and the exf erts therewithin, and then providing a most trusted path connection from that usc r to that expert through the trust network.

While Krysiak appears to disclose a "trust probability," Krysiak does not ever suggest a corresponding valuation criterion and a trust level that is dependent on the co responding valuation criterion.

Regarding claim 24, the Office Action alleges that "Tarrant teaches "recei /ing at one entity a contact identifying another entity; identifying said another entity as a m :mber of a trusted entities list; establishing a business relationship with the sought entity b; sed on the information being indicative of the level of trustworthiness of said another entity". The Office Action further admits that "Tarrant does not specifically teach the degree of separatic ns between the entities." The Office Action alleges (pages 19-20) that:

-22-

In response to the applicant's argument that prior art does not teach querying if the first entity is not a trusted entity and if there is an indication that trusted entities are permitted to forward requests to the other trusted parties, and specifying a predetermined degree of separation, it is notes that Krysiak does teach these features. Specifically, Krysiak teaches that during 'trust search' if the first entity (Bob) has lower level of 'trustworthiness' (self-evaluation) then the other party (Jane or Joe), the request is forwarded to said other parties with indicating a degree of separation [0070]; Figs. 10-14."

However, Krysiak does <u>not</u> teach the feature of "querying, if the first entity is not a trusted entity and if a proxy parameter is indicative that trusted entities are permitted to forward requests to other trusted parties, the trusted entities and **specifying a predetermined degree of separation.**" (Emphasis added.) Specifying a predetermined degree of separation between parties may control the error in assigning activity trust levels. For example, as disclosed by the present patent application (Paragraph 62.):

> In part because the determination of an activity trust level for a particular entity is a subjective judgment, any error in assigning activity trust levels may be magnified as the degrees of separation increase. As a result, a seeking company may want to limit the number of degrees of separation between itself and a sought entity when seeking transitive trust levels. In one embodiment of the invention, rules may be established for associating a maximum number of degrees of separation with trust levels. For example, when seeking a company having an activity trust level of "strategic," a seeking company may limit the search to 1 or 2 degrees of separation and allow greater degrees of separation for lower activity trust levels.

However, Krysiak merely teaches (Paragraph 71):

> Regarding a "trust search," consider that Bob is looking for someone with knowledge in a particular knowledge domain for which this is the representative trust network 320. Bob only knows Jane and his peer-evaluation of her is higher than his self-evaluation in this given knowledge domain (e.g., 6>2). Thus Bob will seek Jane's counsel. Jane, in turn, with a self-evaluation of 4, will seek Sue's counsel because her peer-evaluation of Sue is higher than her self-evaluation (e.g., 9>4); however, Jane will not seek Joe's counsel because her peer-evaluation of him is lower than her self-evaluation for this knowledge domain (e.g. 4>2). Thus, Jane will refer Bob to Sue. Sue, in turn, with a self-evaluation of 5, will seek Sarah's counsel because her peer-evaluation of Sarah is higher than her self-evaluation (e.g. 8>5). Thus, Sue will continue to refer Bob to Sarah, who, since the end of the trust chain has been reached, is the person Bob should ultimately seek to provide the desired counsel. This model assumes a transitive rule of trust in which if user A trusts user B who trusts user C, user A is therefore justified in trusting user C.

While there is a degree of separation between Bob and Jane, Krysiak does not even suggest specifying a predetermined degree of separation. Krysiak teaches that during a trust search (e.g., as initiated by Bob), if the first entity (e.g., Jane) has a lower level of trustworthiness than the other party (e.g., Sarah), the request is forwarded to the other party without considering a predetermined degree of separation. Thus, claim 24 is patentable for at least the above reasons.

Regarding claim 30, the combination of Tarrant and Krysiak does not teach the feature of "querying, if the first entity is not a trusted entity and if a proxy parameter is indicative that trusted entities are permitted to forward requests to other trusted parties, by the second entity at least a third entity of the trusted entities associated with the second entity, and specifying a predetermined degree of separation" as discussed above.

Regarding claim 35, the Office Action has not shown any teachings that even suggest the features of "forwarding, by the third company, based on a respective list of peers thereof and a trust agreement between the first company and the third company, a 'Do You Know' query to further Companies on behalf of the first company, verifying rights management models between all peers" and "responding by the respective company to the third company with an affirmative on knowing the second company, in response to the 'Do You Know' query". The Office Action admits that "Tarrant and Krysiak et al. do not specifically teach forwarding a "Do You Know" query to further companies. Examiner points out that there is no indication in the specification that said feature ("Do You Know" query) provides the advantage over the prior art. Without such indication, it appears that the use of said query **appears to be an obvious variation of relationship inquires.**" (Emphasis added.) While the Office Action alleges the belief that the said feature appears to be obvious, the Office Action fails to provide a teaching that even suggests the feature. Thus, the Office Action has failed to establish *prima facie* obviousness.

Regarding claim 36, the combination of Tarrant and Krysiak does not teach the feature of "querying, if the first entity is not a trusted entity and if a proxy parameter is indicative that trusted entities are permitted to forward requests to other trusted parties, the trusted entities and specifying a predetermined degree of separation" for at least the above reasons.

Claims 22 and 42-43 ultimately depend from claims 21, 24, and 30 and are patentable for at least the above reasons. The Applicants request reconsideration of claims 21-22, 24 30, 35-36, and 42-43.

-24-

Moreover, claim 22 includes the feature of "specifying an acceptable degree of separation and determining whether the existing relationship exists within the specified degree of separation." The Office Action alleges that (Page 15.):

> Krysiak et al. teach[es] said method and system for identifying informat on sources based on one or more trust networks associated with one or m)re knowledge domains, wherein the multiple path connections (degree of separati)n) is provided for identifying the most trusted path connection (Fig. 11-14; [00', 0]-[0076]).

However, Krysiak fails to even suggest specifying an acceptable degree of separation, which is a measure of separation between companies (e.g., as disclosed in Figure 6 and paraграp 1 51 of the present patent application).

Claims 25-29, 31-34, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0128939 (Tarrant) and US 2002/0078003 (Krysiak) in view of US 2002/0152086 (Smith).

Claims 25-29 and 31-34 depend from claim 24 and 30. Moreover, Smith doe ; not make up for the deficiencies of Tarrant and Krysiak, and thus claims 25-29 and 31-34 are patentable for at least the above reasons. Regarding claim 37, the Office Action alleges that (Pag 20):

> In response to the applicant's argument that the prior art does not teach a datal ase structure which is indexed by the capability domain and the activity trust don ain to obtain a corresponding business process, it is noted that Krysiak teaches said method and system, including web pages (databases) displaying informa ion regarding available type of services (capability) (Figs. 3 and 4) and "trustwor hy" rating (Fig. 10).

However, Krysiak does <u>not</u> teach or even suggest the feature of "a respective busines: process of a plurality of business processes being associated with each combination of a respec tive role of the plurality of roles and a respective trust level of the plurality of trust levels, wher in the data structure is indexed by the capability domain and the activity trust domain ti obtain a **corresponding business process.**" (Emphasis added.) Referring to Figs. 3, 4, and 1(, it appears that Krysiak merely teaches obtaining levels of trustworthiness, as presented on Se arch Result Display screen 310 in Fig. 10. Correspondingly, Krysiak teaches (Paragraph 68):

> Referring now to the Search screen 120, which is preferably accessible from any of the representative display screens of FIGS. 3-9, it is preferably used in ord r to locate an expert or other information source in a specific knowledge don ain. Standard Boolean operators are preferably employed, as understood by t 1ose

skilled in the art. The Search screen 120 works in conjunction with the trust engine 52 of the application server 40, the results of which are presented on a Search Result Display screen 310, as representatively depicted in FIG. 10. The Search Result Display screen 310 is preferably categorized by five categories, including a Who category 312, an Others Rating category 314, a Self Rating category 316, a Distance category, and a Path category 319.

Categories, as taught by Krysiak, appear to function as indices. For example, referring to Fig. 10 of Krysiak, one obtains a trustworthiness value of 7.1 for "Jane T" corresponding to Who category 312 and Others Rating category 314. However, Krysiak does not even suggest obtaining a corresponding business operation from the data structure associated with Search Result Display screen 310. Tarrant and Smith does not make up for the deficiencies of Krysiak, and thus claim 37 is patentable over the combination of Tarrant, Krysiak, and Smith. Because claims 38 and 39 depend from claim 37, claims 38 and 39 are patentable for at least the above reasons.

For the reasons, as discussed above, the Applicants request reconsideration of claims 25-29, 31-34, and 37-39.

CONCLUSIONS

All objections and rejections have been addressed. Hence, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

Respectfully submitted,

Date: July 14, 2005

By: _____
Kenneth F. Smolik
Registration No. 44,344
BANNER & WITCOFF, LTD
10 South Wacker Drive
Suite 3000
Chicago, Illinois 60606
Direct Line: 312-463-5419
Facsimile: 312-463-5001

-26-